

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-6, 8-24 and 26-43 are pending in the present application. Claims 1, 20-24, 26-32 and 34 are amended in the present amendment. Claim amendments find support in the claims as originally filed. Thus, no new matter is added.

In the outstanding Office Action, Claims 1-6, 8, 9, 12-14, 16-24, 26, 27, and 30-43 were rejected under 25 U.S.C. 103(a) as unpatentable over Van Hees alone or in view of Kajander et al. (U.S. Pat. No. 6,723,670, herein "Kajander"); and Claims 10, 11, 28 and 29 were rejected under 35 U.S.C. §103(a) as unpatentable over Van Hees, Kajander in further view of Finley (U.S. Pat. No. 5,578,363).

Addressing now the rejection of Claims 1-6, 8, 9, 12-14, 16-24, 26, 27, and 30-43 under §103(a) as unpatentable over Van Hees alone or in view of Kajander, this rejection is respectfully traversed.

Amended Claim 1, recites,

an assembly comprising:
a wood floor directly above and in contact with a material consisting of a felt of mineral fibers, the material consisting of a felt of mineral fibers configured to specifically attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor,
wherein the felt includes binder that is in an amount from 3 to 30% by weight.

Claims 20, 32 and 34 recite similar features with regard to the material.

Van Hees describes a glass fiber mat used for sound insulation of a floating slab.

Further Van Hees describes that the floating slab or screed is made of cement.¹ Additionally,

¹ Van Hees, page 1, line 23.

Van Hees describes that a waterproof material is inserted between the insulating material and the floating slab in order to protect the material from the moisture of the cement.²

M.P.E.P. §2111.03 states that “The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).”

The outstanding Action states on page 4 that “Van Hees teaches an assembly comprising a floor directly above and in contact with (where the waterproof layer is part of the material comprising a felt of mineral fibers) a material comprising a felt of mineral fibers.” However, Van Hees *cannot* be held to describe or suggest “a wood floor directly above and in contact with a material *consisting of* a felt of mineral fibers,” as is recited in Claim 1, at least due to the fact that, in Van Hees, the waterproof material is inserted between the insulating material and the floating slab.

Further, the foam of Kajander also does not describe a material *consisting of* a felt of mineral fibers.

In addition, the outstanding Action acknowledges on page 4 that “Van Hees does not expressly disclose that the floor structure is a wood floor.” Nevertheless the outstanding Action has taken the position on page 3 that “noise produced on the claimed wood floor and that produced on the cement slab [of Van Hees] would be similar enough to constitute an obvious substitution of flooring materials used with the glass mat.”

Applicants respectfully traverse this position as erroneous. The concrete slab described in Van Hees is a thick and heavy plate of cement. The mat of Van Hees may have an effect on the sound transmitted through the floor but will have no effect on the sound emitted in the room itself. In addition, one skilled in the art would know that the frequencies of sound created by contacting the same object under the same conditions against a wood

² Van Hees, page 3, lines 4-16.

floor and against a concrete floor are different. As a result, material designed to address the specific frequencies produced by contact with a wood floor would be different from a material designed to address the specific frequencies produced by contact with a concrete floor.

For example, Exhibit 1 below illustrates that two tissues and a fibre based mat (320 g/m² TEL) can have better sound attenuation properties at certain frequencies. Thus, a material can be specifically designed or configured to attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor due to the fact that this type of impact results in a certain range of frequencies regardless of the object creating the impact. However, this feature is not provided by the fibre mat of Van Hees as the mat of Van Hees is clearly not configured to address sound created by contacting a wood floor.

In addition, the outstanding Action states on page 3 that “it is inherent that the mat would attenuate the sound created in the room whether or not the mat was designed or used for such a purpose.” Applicants also respectfully traverse this position.

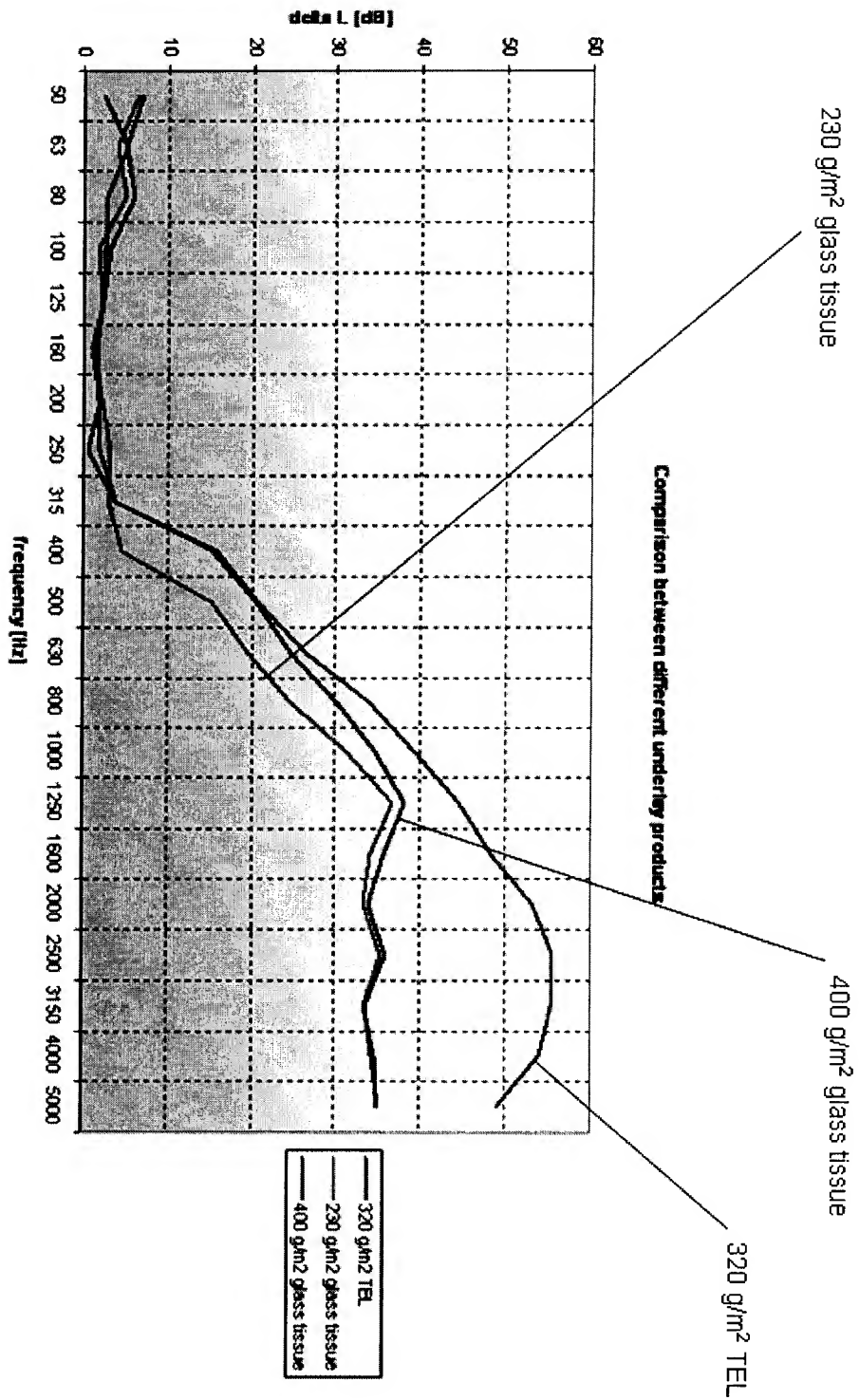
For instance, the mere fact that the mat generally attenuates sound does not mean that the mat is configured to specifically attenuate a noise of an impact with the wood floor emitted in a same room as the wood floor. Clearly the material recited in the claimed invention is specifically designed to reduce sound created by impact with a wood floor something the fibre mat of Van Hees clearly does not specifically accomplish.

Therefore Applicants respectfully submit that the mat of Van Hees is not structurally or functionally equivalent to the material recited in Claim 1.

In addition, Kajander does not cure the above noted deficiencies of Van Hees with regard to the claimed invention.

Accordingly, in light of the above discussion, Applicants respectfully submit that Claims 1, 32 and 34 and claims depending therefrom patentably distinguish over Van Hees and Kajander considered alone or in any proper combination.

Exhibit 1



Consequently, in light of the above discussion and in view of the present amendment, the application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

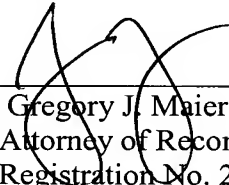
Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

James Love
Registration No. 58,421